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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,688	07/30/2001	Marcos Teres	10001329-1	2187

7590 01/26/2007
HEWLETT-PACKARD COMPANY
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EXAMINER

QIN, YIXING

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	01/26/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/918,688
Filing Date: July 30, 2001
Appellant(s): TERES, MARCOS

MAILED

JAN 26 2007

Technology Center 2600

Christie Doolittle
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 8/4/06 appealing from the Office action mailed 3/13/06

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

USPN 5,386,271	Maekawa et al	1-1995
5,200,958	Hamilton et al	4-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Response to Arguments

Applicant's arguments filed 8/4/06 have been fully considered but they are not persuasive.

1 Applicant argues that one of ordinary skill in the art, would not equate the mere display of information on a monitor with "electronically transmitting a report", as recited in claim 1.

The applicant's specification states on page 8, lines 13-16 that "Where the report is electronically transmitted, it is optionally incorporated in an electronic mail message, transmitted as a text document, or in any other suitable electronic format. This

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electronic transmission optionally utilizes a dial-up connection, or alternatively may be sent via an Internet connection." The spec only describes email or text transmission over an internet connect as optional, but clearly discloses that it can be transferred in any other suitable electronic format. In order for the information to reach the monitor from the CPU 91, the information would have to be transferring in a suitable electronic format for display on the monitor. This is a broad, but reasonable interpretation since the applicant's specification defines the report can be electronically transmitted in a wide range of formats.

The arguments also states that in the present specification, Appellant has recited a variety of output methods, including "displaying the report on a monitor, printing a report on an associated printer or printer system, or electronically transmitting a report" (at page 8, lines 13-15, emphasis added).

The displaying of a report on a monitor and electronically transmitting a report does not necessarily indicate that these are exclusive tasks. One can interpret, for example, that the report is electronically transmitted and then is displayed on a monitor, either locally or remotely.

2. Applicant argues that the burden of establishing a prima facie case of obviousness can only be satisfied by a showing of some objective teaching in the prior art that would lead an individual to combine or modify the relevant teachings of the

references. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art also suggests the desirability of the modification.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reporting of a malfunction is generally available to one of ordinary skill in the art. The electronically transmitting of the report has been discussed above.

3. Applicant argues with particular respect to claim 9, the Examiner has suggested that although Maekawa et al. discloses the display of a report, and does not explicitly disclose sending a report to a printer service facility, that the transfer of data through communications connection such as a LAN or the Internet is well-known and so it would be obvious to one of ordinary skill in the art to send the report to an appropriate location.

Appellant suggests that Maekawa et al. fails to disclose even the existence of an "appropriate location", and reiterate that merely an assertion that the recited modification of the prior art to meet the claimed invention would have been "well within

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the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish a prima facie case of obviousness.

The transferring of the report from one computer/printer to a service facility (which essentially is another computer or server to receive information) has been well known. Maekawa does not necessarily have to disclose an "appropriate location," if it is well known and obvious to have other computers that can received information from the computer in the Maekawa reference. This is simply specific information to be transferred from one computing device to another. Nevertheless, The Examiner points to Limoti (U.S. Patent No. 5,949,533) – column 14, lines 25-31, Sawada (U.S. Patent No. 5,790,916) – Figs. 6, 7 and column 9, lines 17-33 to show that the idea of reporting an error to a remote facility has been known in the art and would have been an obvious addition the Maekawa invention. The point is that the transferring of a report for the purposes of diagnosing an error in an image processing apparatus has been around for a long time and it was not a mere assertion or hindsight to have improved the Maekawa invention using known reporting techniques.

The rejection is thus maintained. Please see the rejection below.

Claim Rejections - 35 USC § 103

I. Claims 1, 5-7, 9-13, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maekawa et al (U.S. Patent No. 5,386,271 – "Maekawa").

Regarding Claims 1, 13, 19, Maekawa discloses a computer-implemented method for diagnosing a malfunction in a printer system using a computer system comprising a processor, the method comprising the steps of:

communicating a present description of one or more symptoms of the printer system malfunction to the processor; (Fig. 25 shows a chart disclosing various conditions and measures to be taken to alleviate those conditions. Fig. 16 shows the processing of a CPU in the center of the control system (column 2, lines 64-65).)

correlating the one or more symptoms with known printer system malfunctions, wherein correlating the one or more symptoms includes comparing the present description of the one or more symptoms to a database relating symptoms to known printer system malfunctions; (Fig. 25 is a database since it stores a collection of information. Columns 2 and 3 of Fig. 25 contain a condition number and a description of that condition. Column 4, "conclusion" is a list of printer malfunctions. In fact, column 15, lines 21-42 discloses the use of the rule weight column of Fig. 25 (i.e. probabilities) to calculate the probability of one or more malfunctions occurring and taking the appropriate steps to remedy the malfunctions.)

identifying a most appropriate malfunction that would produce the described symptoms; (column 11, lines, 51-58 and column 12, lines 1-50 discloses the various processing that can occur. Column 12, lines 47-62, especially, discloses the cause of trouble - i.e. description of symptoms, possibilities and measures to be taken are displayed – i.e. most appropriate malfunctions are reported to user) and

Maekawa does not explicitly disclose "reporting the most appropriate malfunction, where reporting includes electronically transmitting a report (to a service center or a service technician)."

However, as mentioned above in the arguments, the displaying of information (e.g. on a monitor) reads on electronically transferring a report to a service technician. The act of sending the information from the processor to a monitor read on electronically transferring information. Once the information is displayed on the monitor, someone has to look at it in order to take the appropriate measures. Even if corrective measures were automatic, it would still be obvious for someone such as a user or a technician to look at the report that is displayed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for a technician to be looking at the displayed report.

The motivation would have been to allow the technician to take the appropriate steps to remedy malfunctions on a copier or printer.

Therefore, it would have been obvious to have a technician look at the report to obtain the invention as specified.

Regarding claim 5, Maekawa discloses where the description of one or more symptoms of the printer system malfunction is received from the printer system. (This has been addressed in claim 1, where the copying machine sends data to the CPU 91 in response to diagnostics.)

Regarding claim 6, Maekawa discloses where the description of one or more symptoms of the printer system malfunction is received from the printer system operator. (column 15, lines 21-23 shows where a user informs that an "image is faint.")

Regarding claim 7, Maekawa discloses where the step of communicating includes sending a query from the processor to the printer system and receiving descriptions of one or more symptoms of the printer system malfunction from the printer system. (This has been addressed in claim 1, where the copying machine sends data to the CPU 91 in response to diagnostics.)

Regarding claim 9. Maekawa discloses the displaying of a report on a monitor.

It does not explicitly disclose "where the report is electronically transmitted via a communications connection with a printer service facility"

However, the reporting of information to a service facility is essentially a transfer of the report information from the computer in Maekawa to another computer in a remote location. The sending of report information from one location is well known in the art as explained above in the arguments. Limoti (U.S. Patent No. 5,949,533) Sawada (U.S. Patent No. 5,790,916) show that the transferring of a report to a remote computer – which reads on a service facility – has been around for a long time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have transferred the report to another location, such as a service facility.

The motivation would have been to allow remote diagnosis of an error.

Therefore, it would have been obvious to improve Maekawa to obtain the invention as specified.

Regarding claim 10 and 18, Maekawa discloses where the report includes a service procedure recommendation. (Figs. 21 and 22 of Maekawa show that there are probabilities of a certain fault occurring. This essentially acts as a recommendation since a high probability indicates that that fault is more likely to occur and needs more attention than a fault with less or no probability of occurring.)

Regarding claim 11, Maekawa discloses where the service procedure is a part replacement. (Fig. 21 shows that a measure to be taken can be exchange.)

Regarding claim 12, Maekawa discloses where the processor is accessible via an Internet connection. (Maekawa discloses the use of a telephone network as a means of communication.)

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II. Claims 2-4, 14-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maekawa et al (U.S. Patent No. 5,386,271 – “Maekawa”) in view of Hamilton et al (U.S. Patent No. 5,200,958 – “Hamilton”)

Regarding claims 2 and 15, Maekawa discloses the diagnosis of printer errors.

Maekawa does not explicitly disclose “where the description of the one or more symptoms includes an error log recorded by the printer system.”

However, the secondary reference, Hamilton discloses in column 7, lines 65-68, that faults are recorded in a fault log.

Both references are in the art of error diagnosis in a printer environment.

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to include an error log.

The motivation would be to see exactly which errors occurred on a particular printer.

Regarding claims 3 and 4, Maekawa discloses various errors that occurs in a printer in Fig. 25,

It does not explicitly disclose “where the printer system includes a printer input device, and the error log includes input/output device errors.”

However, Hamilton discloses in column 8, lines 18-22 that the diagnostic can identify faults within the “...image input, image output, and image manipulation services.” Hamilton also discloses the error log as addressed above in claims 2 and 15.

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Maekawa and Hamilton are combinable because art of error diagnosis in a printer environment

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have logged input and output errors.

The motivation would have been to allow a technician to have access the history of printer errors in order to prevent errors in the future in the same components.

Therefore, it would have been obvious to combine Maekawa and Hamilton to obtain the invention as specified.

Regarding claims 14 and 20, Maekawa discloses where the processor is directly or indirectly linked to the printer system. (CPU 91 of communicates to the printer via a telephone network).

Regarding claim 16, Maekawa discloses a table of errors and the possibilities of them occurring in Fig. 25. Hamilton discloses the logging of various errors in a printer.

They do not explicitly disclose "comparing the present description to the database relationships includes comparing the error log to the database relationships."

However, as noted in the discussion of the second limitation of claim 13 above, there is an act of correlating errors in Fig. 25 of Maekawa. Although it is not explicitly stated to compare the error log to the database, it would make sense to one of ordinary skill in the art to do so since error logs provide detailed explanations of errors that have

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occurred and thus can help prevent future errors of the same type or notify a technician that particular errors are more likely.

Maekawa and Hamilton are combinable because art of error diagnosis in a printer environment

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have compared the available information.

The motivation would have been to get a better idea of what errors have occurred and are more likely to occur in the future.

Therefore, it would have been obvious to combine Maekawa and Hamilton to obtain the invention as specified.

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(11) Related Proceedings(s) Appendix

No decisions rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the reasons above, it is believed that the rejections should be sustained.

Respectfully submitted,



Yixing Qin

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